



U.S. Pat. No. 6,992,182

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Müller et al.

Serial No.: 09/889,093

U.S. Pat. No. 6,992,182

Filed: Oct. 15, 2001

issued Jan. 31, 2006

Entitled: METHOD FOR ISOLATING DNA FROM
BIOLOGICAL MATERIALS

Atty. Docket No.: QGN-020.0P US

Mail Stop Petition
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

06/26/2006 TBESHAKH2 00000116 6992182

02 FC:1461

130.00 OP

PETITION FOR SUSPENSION OF RULES
PURSUANT TO 37 C.F.R. §1.183 AND WAIVER OF 37 C.F.R. §3.81

Sir:

Pursuant to 37 C.F.R. §1.183, Patentees request suspension of the rules and waiver of 37 C.F.R. §3.81 as necessary to permit an additional assignee to be listed on the cover sheet of U.S. Pat. No. 6,992,182 issued Jan. 31, 2006. The petition fee of \$130.00 pursuant to 37 C.F.R. §1.17(h) is enclosed herewith (check no. 7001). A request for a Certificate of Correction pursuant to 37 C.F.R. §1.323 is filed concurrently herewith.

REMARKS

A Notice of Allowance issued in the above-referenced application on Sept. 12, 2005. Issue Fee Transmittal form PTOL-85 was filed with the issue fee on Nov. 10, 2005. In Box 3 of the Transmittal Form one assignee was incorrectly listed, namely, ~~Agencia de la Invencio~~ (Duisburg, Germany); however, by innocent oversight and without deceptive intent, co-assignee Max-Planck-Gesellschaft zur Förderung der Wissenschaften (Munich, Germany) was not also listed.

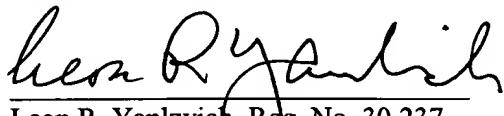
Patentees submit this petition to request that the omitted co-assignee be listed on the patent.

Copies of the recorded assignments to Qiagen GmbH and to Max-Planck-Gesellschaft zur Förderung der Wissenschaften are attached. Copies of the Notice of Recordation of Assignment Document issued by the Patent Office in respect of each of the assignments are also included.

Also enclosed herewith is a Request for a Certificate of Correction pursuant to 37 C.F.R. §1.323, together with the fee of \$100.00 pursuant to 37 C.F.R. §1.20(a) (check no. 7002), and a Certificate of Correction on form PTO/SB/44.

A suspension of the rules and issuance of a Certificate of Correction to have both above-referenced Assignees appear on the cover page of the patent are respectfully requested.

Respectfully submitted,



Leon R. Yankwich, Reg. No. 30,237
Michael R. Wesolowski, Reg. No. 50,944
Attorneys of Record
YANKWICH & ASSOCIATES, P.C.
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Cambridge, Massachusetts 02139
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CERTIFICATE OF MAILING

The undersigned hereby certifies that this correspondence is being deposited with the U.S. Postal Service as first class mail, in an envelope addressed to the Commissioner of Patents, **Office of Petitions**, Washington, DC 20231, on the date indicated below.

June 19, 2006

date



Nasim G. Memon

OCTOBER 30, 2001



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

YANKWICH & ASSOCIATES
LEON R. YANKWICH
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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

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RECORDATION DATE: 10/30/2001

REEL/FRAME: 012109/0594
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNEE'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNEE:

MULLER, OLIVER

DOC DATE: 10/01/2001

ASSIGNOR:

SPRENGER-HAUSSELS, MARKUS

DOC DATE: 10/09/2001

ASSIGNEE:

MAX-PLANCK-GESELLSCHAFT ZUR
FORDERUNG DER WISSENSCHAFTEN
HOFGARTENSTRASSE 2
D-80539 MUNICH, FED REP GERMANY

SERIAL NUMBER: 09889093

FILING DATE:

PATENT NUMBER:

ISSUE DATE:

SHARON BROOKS, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

PATENTS ONLY

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| | |
|---|--|
| 1. Name of conveying party(ies): Oliver MÜLLER, Markus SPRENGER-HAUSSELS | 2. Name and address of receiving party(ies): Name: <u>Max-Planck-Gesellschaft zur Förderung der Wissenschaften</u> Internal Address: _____ |
| Additional name(s) of conveying parties(ies) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No | |
| 3. Nature of conveyance: <input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Security Agreement <input type="checkbox"/> Change of Name <input type="checkbox"/> Other | Street Address: <u>Hofgartenstrasse 2</u> <u>D-80539 Munich</u> Country: <u>Germany</u> |
| Execution Date: <u>October 1, 2001 – October 9, 2001</u> | |
| Additional name(s) & address(es) attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No | |

4. Application number(s) or patent numbers:

If this document is being filed together with a new application, the execution date of the application is:

| | |
|--|---|
| A. Patent Application No.(s) <u>U.S. Appln. No. 09/889,093, filed July 10, 2001</u> | B. Patent No.(s) |
| Additional numbers attached? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No | |
| 5. Name and address of party to whom correspondence concerning the document should be mailed: Name: <u>Leon R. Yankwich</u> Internal Address: <u>Yankwich & Associates</u> Street Address: <u>130 Bishop Allen Drive</u> City: <u>Cambridge</u> State: <u>MA</u> ZIP: <u>02139</u> | 6. Total number of applications and patents involved: <u>one (1)</u> |
| 7. Total fee (37 CFR 3.41)...\$ <u>40.00</u> <input checked="" type="checkbox"/> Enclosed <input type="checkbox"/> Authorized to be charged to PTO deposit account | |
| 8. Deposit Account number: <u>50-0268</u> | |
| (Attach duplicate copy of this page if paying by deposit account) | |

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9. Statement and signature. *To the best of my knowledge and belief, the foregoing information is true and correct, and any attached copy is a true copy of the original document.*

Leon R. Yankwich

Name of Person Signing

Signature

Date


Oct. 24, 2001

Total number of pages comprising cover sheet: 1

OMB No. 0651-0011 (exp. 4/94)

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ASSIGNMENT

We,

(1) Oliver MÜLLER, and

(2) Markus SPRENGER-HAUSSELS

residing, respectively, at

44139
(1) Harnackstrasse 61, D-44236 Dortmund (DE), and

(2) Grünstrasse 52, D-42697 Solingen (DE)

1. Oct 2001
OZ/CB

both citizens of Germany, for good and valuable consideration, receipt of which is hereby acknowledged, have assigned, sold and transferred to and do hereby assign, sell and transfer to MAX-PLANCK-GESELLSCHAFT ZUR FÖRDERUNG, a corporation organized and existing under the laws of Germany and having an office and a place of business at Hofgartenstrasse 2, D-80539 Munich, Germany, its successors and assigns:

1) the entire right, title and interest in the United States and in all countries throughout the world in and to any and all my/our inventions and discoveries disclosed in U.S. Patent Application Ser. No. 09/889,093, filed July 10, 2001 and entitled: "METHOD FOR ISOLATING DNA FROM BIOLOGICAL MATERIALS" {Atty. Docket No. QGN-020.0P US (19619P US-WO/WWbj)}, including any renewals, revivals, reissues, reexaminations, extensions, continuations and divisions thereof, and any substitute applications therefor;

2) the full and complete right to file patent applications in the name of Max-Planck-Gesellschaft zur Förderung, its designee, or in our names at the election of Max-Planck-Gesellschaft zur Förderung or its designee, on the aforesaid inventions, discoveries and applications in all countries of the world;

3) the entire right, title and interest in and to any Letters Patent which may issue thereon in the United States or in any other country of the world and any renewals, revivals, reissues, reexaminations and extensions of the same; and

4) the entire right, title and interest in all Convention and Treaty Rights of all kinds thereon, including without limitation all rights of priority in any country of the world, in and to the above inventions, discoveries and applications.

We hereby authorize and request the competent authorities to grant and to issue any and all such Letters Patent in the United States and throughout the world to Max-Planck-Gesellschaft zur Förderung as the assignee of the entire right, title and interest therein, as fully and entirely as the same would have been held and enjoyed by us had this assignment, sale and transfer not been made.

We agree, at any time, upon the request of Max-Planck-Gesellschaft zur Förderung to execute and to deliver to Max-Planck-Gesellschaft zur Förderung any additional applications for patents for said inventions and discoveries, or any part or parts thereof, and any applications for patents of confirmation, registration and importation based on any Letters Patent issuing on said inventions, discoveries or applications, and divisions, continuations, renewals, revivals, reissues, reexaminations and extensions thereof.

We further agree at any time to execute and to deliver upon request of Max-Planck-Gesellschaft zur Förderung such additional documents, if any, as are necessary or desirable to secure patent protection on said inventions, discoveries and applications throughout all countries of the world, and otherwise to do the necessary to give full effect to and to perfect the rights of Max-Planck-Gesellschaft zur Förderung under this Assignment, including the execution, delivery and procurement of any and all further documents evidencing this assignment, transfer and sale as may be necessary or desirable.

ASSIGNORS:

(1) 
OLIVER MÜLLER

DATE OF
SIGNING:

1. October 2001
date

WITNESSED BY:

(1) 
Witness:

(2) 
MARKUS SPRENGER-HAUSSELS

2. October 2001
date

(2) 
Witness:

OCTOBER 31, 2001



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

YANKWICH & ASSOCIATES
LEON R. YANKWICH
130 BISHOP ALLEN DRIVE
CAMBRIDGE, MA 02139
OCT 31 2001
Orchard

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RECORDATION DATE: 10/30/2001

REEL/FRAME: 012113/0961
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNEE'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNEE:
BASTIAN, HELGE

DOC DATE: 10/09/2001

ASSIGNEE:
VOLLERT, STEFANIE

DOC DATE: 09/29/2001

ASSIGNEE:
QIAGEN GMBH
MAX-VOLMER-STRASSE 4
IP & LICENSING
40724 HILDEN, FED REP GERMANY

SERIAL NUMBER: 09889093
PATENT NUMBER:

FILING DATE:
ISSUE DATE:

PAULA MCCRAY, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

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Helge BASTIAN, Stefanie VOLLERT

Additional name(s) of conveying parties(ies) attached? Yes No

3. Nature of conveyance:

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| <input type="checkbox"/> Security Agreement | <input type="checkbox"/> Change of Name |
| <input type="checkbox"/> Other | |

Execution Date: September 29, 2001 – October 9, 2001

4. Application number(s) or patent numbers:

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

U.S. Appln. No. 09/889,093, filed July 10, 2001

B. Patent No.(s)

Additional numbers attached? Yes No

5. Name and address of party to whom correspondence concerning the document should be mailed:

Name: Leon R. Yankwich

Internal Address: Yankwich & Associates

Street Address: 130 Bishop Allen Drive

City: Cambridge State: MA ZIP: 02139

6. Total number of applications and patents involved:
one (1)

7. Total fee (37 CFR 3.41)...\$ 40.00

- | |
|---|
| <input type="checkbox"/> Enclosed |
| <input checked="" type="checkbox"/> Authorized to be charged to PTO deposit account |

8. Deposit Account number:

50-0268

(Attach duplicate copy of this page if paying by deposit account)

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Leon R. Yankwich

Name of Person Signing

Signature

Oct. 24, 2001

Date

Total number of pages comprising cover sheet: 1

OMB No. 0651-0011 (exp. 4/94)

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ASSIGNMENT

We,

(1) Helge BASTIAN, and

(2) Stefanie VOLLETT

residing, respectively, at

(1) Benrather Schloßallee 94a, 40597 Düsseldorf (DE), and

(2) Hainerweg 11, D-65719 Hofheim-Lorsbach (DE)

both citizens of Germany, for good and valuable consideration, receipt of which is hereby acknowledged, have assigned, sold and transferred to and do hereby assign, sell and transfer to QIAGEN GmbH, a corporation organized and existing under the laws of Germany and having an office and a place of business at Max-Volmer-Strasse 4, 40724 Hilden, Federal Republic of Germany, its successors and assigns:

1) the entire right, title and interest in the United States and in all countries throughout the world in and to any and all my/our inventions and discoveries disclosed in U.S. Patent Application Ser. No. 09/889,093, filed July 10, 2001 and entitled: "METHOD FOR ISOLATING DNA FROM BIOLOGICAL MATERIALS" {Atty. Docket No. QGN-020.0P US (19619P US-WO/WWbj)}, including any renewals, revivals, reissues, reexaminations, extensions, continuations and divisions thereof, and any substitute applications therefor;

2) the full and complete right to file patent applications in the name of QIAGEN GmbH, its designee, or in our names at the election of QIAGEN GmbH or its designee, on the aforesaid inventions, discoveries and applications in all countries of the world;

3) the entire right, title and interest in and to any Letters Patent which may issue thereon in the United States or in any other country of the world and any renewals, revivals, reissues, reexaminations and extensions of the same; and

4) the entire right, title and interest in all Convention and Treaty Rights of all kinds thereon, including without limitation all rights of priority in any country of the world, in and to the above inventions, discoveries and applications.

We hereby authorize and request the competent authorities to grant and to issue any and all such Letters Patent in the United States and throughout the world to QIAGEN GmbH as the assignee of the entire right, title and interest therein, as fully and entirely as the same would have been held and enjoyed by us had this assignment, sale and transfer not been made.

We agree, at any time, upon the request of QIAGEN GmbH, to execute and to deliver to QIAGEN GmbH any additional applications for patents for said inventions and discoveries, or any part or parts thereof, and any applications for patents of confirmation, registration and importation based on any Letters Patent issuing on said inventions, discoveries or applications, and continuations, renewals, revivals, reissues, reexaminations and extensions thereof.

We further agree at any time to execute and to deliver upon request of QIAGEN GmbH such additional documents, if any, as are necessary or desirable to secure patent protection on said inventions, discoveries and applications throughout all countries of the world, and otherwise to do the necessary to give full effect to and to perfect the rights of QIAGEN GmbH under this Assignment, including the execution, delivery and procurement of any and all further documents evidencing this assignment, transfer and sale as may be necessary or desirable.

ASSIGNORS:

DATE OF SIGNING:

WITNESSED BY:

(1) Helge Bastian
HELGE BASTIAN

9/10/01
date

(1) B. Rögl
Witness:

(2) S. Vollert
STEFANIE VOLLERT

29/09/01
date

(2) B. Rögl
Witness: